

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Cheng Zhou, Rangarajan Venkastesan, Joshua Toub		
Assignee:	Versata Development Group, Inc.		
Title:	METHOD AND APPARATUS FOR NET-PAY AND DEBT CONSOLIDATION		
Application No.:	09/810,519	Filed:	March 15, 2001
Examiner:	Daniel S. Felten	Group Art Unit:	3696
Docket No.:	T00066	Customer No.:	33438

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January 27, 2010

**ARGUMENTS FOR WHICH THE PRE-APPEAL BRIEF REVIEW IS BEING REQUESTED**

This paper presents arguments responsive to the Final Office Action dated July 27, 2009, having a shortened statutory period expiring October 27, 2009. Accompanying these arguments is a Notice of Appeal, a Pre-Appeal Brief Request for Review, and a petition under 37 C.F.R. § 1.136 for extension of time by three (3) months, setting a new time for response of January 27, 2010.

**Claim Status:**

Claims 1-4, 6, 7, 10, 12, 13, 37-40, 42, 43, 46, and 48-50 are pending. (Note: The *Office Action* lists only claims 1-4, 6, 7, 10, 12, and 13 as pending. However, claims 1-4, 6, 7, 10, 12, 13, 37-40, 42, 43, 46, and 48-50 were elected in response to the previous restriction requirement and are listed in the *Office Action* as rejected under 35 U.S.C. § 102(e)).

Claims 1-4, 6, 7, 10, 12, and 13 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1-4, 6, 7, 10, 12, 13, 37-40, 42, 43, 46, and 48-50 stand rejected under 35 U.S.C. § 102(e).

**ARGUMENTS**

**Summary of Arguments**

- I. The rejection under 35 U.S.C. § 101 is improper.
- II. The rejection under 35 U.S.C. § 112, second paragraph, is improper.

- III. Even if the rejections under 35 U.S.C. § 101 and/or 35 U.S.C. § 112, second paragraph, are sustained, the rejections cannot be the basis for a final rejection.
- IV. The rejection under 35 U.S.C. § 102(e) is improper.
- V. A rejection under 35 U.S.C. § 103 cannot be made using the *Koppelman* reference.

The Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984).

References herein to the “*Office Action*” refer to the July 27, 2009 Final Office Action.

### I.

Claims 1-4, 6, 7, 10, 12, and 13 stand rejected under 35 U.S.C. § 101. Claims 1-4, 6, 7, 10, 12, and 13 are limited to a method “using a computer system.” Thus, claims 1-4, 6, 7, 10, 12, and 13 are tied to a particular machine as required by *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

### II.

Claims 1-4, 6, 7, 10, 12, and 13 stand rejected under 35 U.S.C. § 112, second paragraph. The *Office Action* states that the claims:

stand rejected as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: is the computer system a singular system or a multiple device computer system with peripheral devices that carry out each of the steps in the method? What structures are used to carryout each of the method steps?

MPEP § 2172.01 states in relevant part:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

The Examiner has not provided any support for the rejection under 35 U.S.C. § 112, second paragraph. Claims 1-4, 6, 7, 10, 12, and 13 are limited to being performed using a

computer system. However, setting aside that the rejection, if proper, should be made under 35 U.S.C. § 112, first paragraph, the *Office Action* has cited no basis in the Present Application that certain specific structures of a computer system, such as a singular system or a multiple device computer system, are essential to the invention. Without such basis, the Examiner's rejection of the claims for omitting essential structural cooperative relationships of elements is improper.

Additionally, the rejected claims are all method claims and are not required to contain structural limitations.

Accordingly, the rejection under 35 U.S.C. § 112, second paragraph is improper.

### III.

The rejection of claims 1-4, 6, 7, 10, 12, and 13 under 35 U.S.C. §§ 101 and 112, second paragraph, have been raised in the first instance as part of the final rejection of the *Office Action*. Accordingly, even if the rejections under 35 U.S.C. §§ 101 and 112, second paragraph, are sustained (contrary to Applicants' arguments in sections I and II herein), the rejections under 35 U.S.C. §§ 101 and 112 alone or together cannot be the basis for a final rejection.

If the pre-appeal brief review panel agrees that the 35 U.S.C. § 102(e) and any 35 U.S.C. § 103(a) rejection are improper as subsequently argued by Applicants in sections IV and V herein, then the 35 U.S.C. §§ 101 and/or 112 rejections would be the only rejections sustained in the *Office Action*.

The MPEP § 706.07a states in part:

Under present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement.

The rejection of claims 1-4, 6, 7, 10, 12, and 13 under 35 U.S.C. §§ 101 and 112 have been raised in the first instance as part of the final rejection of the *Office Action*. The claims had not been amended after the previous August 25, 2008 non-final rejection and, thus, Applicants' actions cannot have necessitated the new grounds of rejections. Additionally, the rejections are not based on information submitted in an information disclosure statement.

Accordingly, the rejections under 35 U.S.C. §§ 101 and/or 112 alone provide an improper basis for a final rejection. Thus, if Applicants' arguments in the below sections IV and V are

accepted and Applicants' arguments in sections I and/or II are rejected, then the final office action must be withdrawn in favor of a non-final rejection to provide Applicants a fair opportunity to respond.

#### IV.

The immediately preceding Office Action rejected claims 1-4, 6, 7, 10, 12, 13, 37-40, 42, 43, 46, and 48-50 as being unpatentable under 35 U.S.C. § 103(a) in view of U.S. Patent No. 6,662,164 (referred to herein as "*Koppelman*"). In response to the rejection, Applicants established that under 35 U.S.C. § 103(c)(1) *Koppelman* is not a proper reference under 35 U.S.C. § 103(a).

In the Examiner's response to Applicants' response, the Examiner changed the basis of the rejection from 35 U.S.C. § 103(a) to 35 U.S.C. § 102(e). "To anticipate [under 35 U.S.C. § 102], every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001).

The Office Action itself admits that *Koppelman* does not teach every element and limitation of the claimed invention as required for a rejection under 35 U.S.C. § 102(e). The Office Action states that "*Koppelman* discloses various rules which contain conditions that must be met (see column 11, lines 12+), but fails to disclose repayment rules per se. The "repayment rules" of the claims are contained in two elements of claim 1 and the Examiner admits that *Koppelman* fails to disclose the "repayment rules" of claim 1. The Office Action subsequently states that, "Thus it would have been obvious for an artisan of ordinary skill in the art to provide a (sic) repayment rules for advances received by a distributor ... . Thus a modification would be an obvious expedient to one of ordinary skill in the art." Office Action, p. 4.

Thus, Office Action itself admits that *Koppelman* does not teach every element and limitation of the claimed invention as required for a rejection under 35 U.S.C. § 102(e) and improperly bases the 35 U.S.C. § 102(e) rejection under an "obvious" standard.

Accordingly, the rejection under 35 U.S.C. § 102(e) is improper.

V.

The following arguments were originally submitted in Applicants' response to the immediately preceding, May 5, 2008 non-final rejection. Applicants respectfully submit that *Koppelman* is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a). *Koppelman* qualifies as prior art under 35 U.S.C. § 102(e) and that the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

More specifically, Title 35 U.S.C. § 103(c)(1) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

*Koppelman* was filed on May 19, 1998 and first published on December 9, 2003, the *Koppelman* issue date. The present application was filed on June 29, 2001. Thus, *Koppelman* qualifies as prior art under 35 U.S.C. § 102(e). Applicants submit that the present application and *Koppelman* were, at the time the present invention was made, owned by, or subject to an obligation of assignment to, Trilogy Development Group, Inc.

Since *Koppelman* and the claimed invention of the present application were, at the time the claimed invention was made, subject to an obligation of assignment to the same person, *Koppelman* qualifies as prior art only under 35 U.S.C. § 102(e), in accordance with 35 U.S.C. § 103(c)(1), *Koppelman* cannot be used as part of a rejection based upon 35 U.S.C. § 103.

Thus, Applicant respectfully submits that *Koppelman* is not a proper reference against the present invention under 35 U.S.C. § 103.

CERTIFICATE OF TRANSMISSION

I hereby certify that on January 27, 2010, this correspondence is being transmitted via the U.S. Patent & Trademark Office's electronic filing system.

/Kent B. Chambers/

Respectfully submitted,

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